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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,600	07/28/2003	David S. Kim	624-001 Cont.	4654

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EXAMINER

MITCHELL, TEENA KAY

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,600

Applicant(s)

KIRN, DAVID S.

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/10/03</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Priority***

While applicant in the first line of the specification, does list that the instant application as a Continuation of application 09/939,399, applicant must also list the current status of the 09/939,399 application (i.e., US patent 6,631,715).

Correction is required.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 5 of U.S. Patent No. 6,631,715. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claim 1 of the instant application a bridle system for placing and securing at least one tube in a patient comprising: a member having a first and second ends, said first end for insertion into a first nare of a nose (the limitation found in lines 1-4 of the

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patented claim 1; the instant application claim merely lacks the limitation of the member being flexible, the limitation of flexible would be obvious to one of ordinary skill in the art because the member must have some flexibility in order to be inserted into a nare of a user); a magnet secured within said first end (the limitation found in line 5 of the patented claim 1; the only limitation missing is the use of the word "substantially"); a magnetic probe for insertion into a second nare of the nose to attract said magnet and retrieve said magnet and said first end of said member (the limitations found in lines 6-8 of the patented 1, again the only limitation missing is the word "flexible" which would be obvious to one of ordinary skill in the art because if inserted into a nare the member has to have somewhat flexible); a receiver for securing the at least one tube (limitations can be found in lines 9 and 10 of patented claim 1). Claim 1 of the instant application is broader than patented claim 1, patented claim 1 has more limitations and is thus more specific. Patented claim 1 "anticipates" application claim 1. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

**With respect to claim 2 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 3 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 4 of the instant application**, the limitations can be found in lines 1-3 of patented claim 5.

**With respect to claim 5 of the instant application**, the limitations can be found in line 2 of patented claim 2.

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**With respect to claim 6 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 7 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 8 of the instant application**, a flexible member having first and second ends said first end for insertion into a first nare of a nose (the limitations can be found in lines 1-4 of patented claim 1); a magnet secured within said first end (the limitations can be found in line 5 of patented claim 1; the difference being the word "substantially" however, it would be obvious to one of ordinary skill in the art that if the magnet is substantially secured it is thus "secured" and therefore the patented claim "anticipates" the instant application claim); a probe for insertion into a second nare of the nose to attract said magnet and retrieve said magnet and said first end of said flexible member (the limitations can be found in lines 7 and 8 of patented claim 1; the only difference being the word "magnetic" however, therefore the patented claim "anticipates" the instant application claim); and a receiver for securing the at least one tube (the limitations can be found in line 9 of patented claim 1).

**With respect to claim 9 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 10 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 11 of the instant application**, the limitations can be found in lines 1-3 of patented claim 5.

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**With respect to claim 12 of the instant application**, the limitations can be found in lines 1 and 2 of patented claim 2.

**With respect to claim 13 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 14 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 15 of the instant application**, the limitations can be found in patented claim 1. The limitations missing are the words "flexible", however, the limitation of flexible would be obvious to one of ordinary skill in the art because the member must have some flexibility in order to be inserted into a nare of a user.

**With respect to claim 16 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 17 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 18 of the instant application**, the limitations can be found in lines 1 and 2 of patented claim 2.

**With respect to claim 19 of the instant application**, the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 20 of the instant application**, the limitations can be found in patented claim 1. The missing limitations are the words "secured substantially" and "magnetic", however it would have been obvious to one of ordinary skill in the art that if the magnet is "attached" it is secured and if the

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magnet is secured it meets the limitation of being substantially. It would also be obvious the probe would be magnetic in order for the probe to retrieve the magnet.

**With respect to claim 21 of the instant application,** the limitations can be found in lines 9 and 10 of patented claim 1.

**With respect to claim 22 of the instant application,** the limitations can be found in lines 9 and 10 of patented claim 1; and lines 1 and 2 of patented claim 2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (703) 308-4016. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Teena Mitchell  
Examiner  
Art Unit 3743  
June 26, 2004